

Application No. 09/611,620

## REMARKS

I. STATUS OF THE CLAIMS

In the application claims 49-75 remain pending. Claims 1-48 have been canceled. No claims presently stand allowed. The reconsideration of the rejection of the claims is respectfully requested.

II. THE REJECTION OF THE CLAIMS

Claims 49-72 stand rejected under 35 U.S.C § 103 as being obvious over U.S. Patent No 6,289,165 ("Abecassis") as modified by the teachings of U.S. Patent No. 6,040,829 ("Croy"). In rejecting claims 49-72, it was generally set forth that Abecassis discloses function keys 212 that provide, for example, subject category selection, content preference selection, and source selection, which has been asserted to correspond to a plurality of navigation keys that are accessible to transmit command codes for commanding the operation of a consumer electronic device to navigate a menu of a digital media playable on the consumer electronic device. While it was acknowledged that Abecassis fails to disclose the claimed storage means for storing a sequence of activations of the keys and means for repeating the stored sequence, it was asserted that Croy, which teaches a save function that allows a user to record a sequence of key activations and associate a name with the sequence to recall a list of programs, discloses a storage means for storing a sequence of activations of the keys as well as a means for repeating the stored sequence. Thus, with respect to the obviousness rejection, it was concluded that it would have been obvious to modify Abecassis using the teachings of Croy to arrive at the claimed invention "because this would provide automated capabilities for efficiently retrieving and playing only a specified class, category, or

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subject mater included in segments within the selected video or set of videos as may be available from a database or videos.”

Claims 73-75 stand rejected under 35 U.S.C. § 102 as being anticipated by Croy. In rejecting claims 73-75, it was asserted that Croy teaches the two-way transmission of data between a base station 100 and a remote control device 100 including a processor connected to the communication system where a marked program may be selected and additional information requested or programmed into a VCR. It was further asserted that a delete softkey allows removal of a marked program from the list if it is not of interest anymore and that this corresponds to the programming operable with the processor and the bi-directional communication system for receiving data from the player used to define navigation commands transmittable to the player for controlling navigation within the menu system and for storing a sequence of the navigation commands for subsequent transmission to the player.

### III. APPLICABLE LAW

It is well settled that an obviousness rejection, like an rejection under 35 U.S.C. § 102, requires that a combination of prior art references disclose each and every element set forth in a claim under consideration. In this regard, each word of a claim must be considered when determining if a claim is anticipated or rendered obvious. Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

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#### IV. THE CLAIMED INVENTION

The claimed invention is distinct from the cited references since the claimed invention is directed to a remote control that monitors user input *while the remote control is being used to transmit commands to an appliance*, that stores this keystroke data *while the transmission of commands occurs*, and which allows the stored keystroke data to be repeated to thereby *repeat the transmission of the commands to the appliance*. The claimed invention thus provides the user with the ability to repeat a sequence of transmitted commands *after the fact, i.e., after they have already been once transmitted*. The saved key sequences are transparently saved by the remote control *as the navigation commands are transmitted* by the user of the remote control to the appliance in the first instance.

The claimed invention is also directed to a remote control the receives data from a digital media player that is used to define navigation commands that are transmittable to the digital media player for controlling navigation within the menu system of the digital media player and for storing a sequence of the navigation commands for subsequent transmission of those navigation commands to the digital media player.

#### V. ABECASSIS DOES NOT DISCLOSE WHAT THE OFFICE ACTION ALLEGES IS DISCLOSED BY ABECASSIS

The Office Action asserts that "Abecassis teaches a function keys 212 also provide, for example, subject category selection, content preference selection, and source selection 219 (column 10, lines 14-17) *corresponding to a plurality of keys including navigation keys that are activatable to transmit command codes for commanding the consumer electronic device to navigate a menu of a digital media playable on the consumer electronic device.*" The italicized portion of this assertion finds no support

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anywhere in the disclosure of Abecassis. In fact, turning to column 10, lines 14-19, Abecassis states that "pressing one of the i-v keys 212 results in an appropriate new menu of labels and/or icons to be displayed 203." As can be seen in Fig. 2, display 203 is quite clearly situated on the remote control, not the media playback device or TV screen, and the possible icons etc. are clearly illustrated at 209. Further, the cited paragraph is the only place in the entire disclosure of Abecassis that function keys 212 are referenced. Thus, since there is nothing within the four corners of Abecassis that expressly or implicitly teaches that the activation of keys 212 causes the transmission of command codes for commanding the consumer electronic device to navigate a menu of a digital media playable on the consumer electronic device, the rejection of the claims cannot be maintained.

**VI. CROY AND ABECASSIS IN COMBINATION FAIL TO DISCLOSE EACH AND EVERY CLAIM LIMITATION CONSIDERING EACH AND EVERY WORD**

The Office Action has not demonstrated, nor does it even mention, where either Croy or Abecassis disclose, teach, or suggest the expressly claimed automatically storing a sequence of key activations, including navigation keys, when the keys are activated to transmit command codes for commanding the consumer electronic to navigate a menu of a digital media (playable on the consumer electronic device) or the expressly claimed means for repeating the stored sequence of activations of the keys to thereby cause a retransmission of command codes corresponding to those activations of the keys that are within the stored sequence.

That Abecassis fails to disclose, teach, or suggest these claim elements is expressly set forth in the Office Action.

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While the Office Action asserts that Croy teaches a save function and a recall function, the Office Action never asserts that this save function and recall function operates in the claimed manner. The Office Action never asserts that those claim elements that are missing from Abecassis can be found in the express language of Croy. When discussing Croy, the Office Action never states that the Croy save function “automatically stores a sequence of key activations, including navigation keys, when the keys are activated to transmit commands for commanding the consumer electronic to navigate a menu of a digital media (playable on the consumer electronic device).” Likewise, the Office Action never states that the Croy recall function “causes a retransmission of command codes corresponding to those activations of the keys that are stored within the sequence.”

More specifically, while the Office Action has asserted that Croy:

teaches a save function that allows a user to record a sequence of user function key activations and associate a name with the particular sequence of actions corresponding to a storage means for storing a sequence of activations of the keys...and the user may simply press “recall” and “Music” to receive a list of programs that meet these particular qualifiers according to the preselected user preferences corresponding to means for repeating the stored sequence.

it is noted that this assertion never states that Croy uses this procedure to transmit and retransmit commands to an appliance, i.e., the word “transmit” does not even appear in this assertion. *Thus, the applicants respectfully request that the Examiner specify where within Croy it is disclosed that commands are transmitted to an appliance when the user records the sequence of menu navigation keys and where within Croy it is disclosed that commands are retransmitted to an appliance when the “recall” and “music” keys are activated.*

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Absent such disclosure, it is submitted that the combination of Croy and Abecassis cannot be said to meet the requirements for a prima facie case of obviousness, i.e., the combination of Croy and Abecassis does not disclose each and every word of the claims, and as such, the rejection must be withdrawn.

**VII. CROY SIMPLY DOES NOT DISCLOSE, TEACH, OR SUGGEST SAVING KEYSTROKE DATA WHEN KEYS ARE ACTIVATED TO TRANSMIT COMMANDS TO AN APPLIANCE AND DOES NOT DISCLOSE THE RETRANSMISSION OF THE KEYSTROKE COMMANDS**

It is further respectfully submitted that the reason that the Office Action fails to assert that the noted claim elements are disclosed within Croy is for the very reason that Croy, like Abecassis, simply fails to disclose the noted claim elements. As discussed in the previously filed responses, Croy discloses entering a programming mode whereafter key activations may be monitored and stored to allow a user to navigate a locally stored menu, i.e., a menu that is displayed on the personal navigator itself. When navigating the locally stored menu, the key activations simply do not function to transmit command codes to a consumer appliance.

More particularly, Column 18, lines 33-67 cited to in the Office Action, describes a system that accepts explicit user input to initiate a special programming mode (e.g., selecting the "save" function from a menu as illustrated in Fig. 38) whereupon the user may enter a sequence of user interactions by interacting with the locally displayed menu. (Col. 18, line 49 – Col. 19, line 1 and Figs. 39, 40 and 41). *Croy does not mention nor does Croy infer that commands are transmitted from the remote control to a controlled device while the user is interacting with the locally displayed menu in this programming mode.* Once the sequence is complete, the user assigns a name to the sequence (Col. 19, lines 2-7 and Fig. 42) whereby that sequence can be recalled by selecting a "recall"

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function and the name of the sequence to be executed (Col.19, lines 11-16) which, upon execution, causes a program listing to be displayed locally on the remote control (as illustrated in Fig. 46) in accordance with the programmed sequence. Since this execution of the stored sequence is described and illustrated as only effecting the screen display of the remote control, i.e., the remote control only performs a local operation, it is clear that *Croy does not mention nor does Croy infer that commands are transmitted from the remote control to a controlled device when the user creates and then recalls the stored sequence.*

As noted above, if it cannot be demonstrated where Croy discloses those claim elements that have been acknowledged to be missing from Abecassis, which it does not, the rejection of the claims must be withdrawn.

**VIII. THE EXAMINER MUST CITE TO A REFERENCE TO  
CORROBORATE CERTAIN ASSERTIONS MADE IN THE OFFICE  
ACTION**

The Office Action has asserted that "...and any television remote control has the same exact feature where the key pressed is automatically stored in the memory and can be reactivated or repeat or retransmit the next time the consumer electronic device is on." The Office Action has also asserted that "any normal TV remote control has the exact same functionality [of transmitting commands from the remote control to a controlled device while the user is interacting with the locally displayed menu in a programming mode]."

With regard to these assertions, the applicants, as has been done in every prior response, submit that it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference. Accordingly, in accordance with MPEP § 2144.03,

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the applicants once again request that the Examiner place some form of evidence into the record to support the above-noted assertions. Absent some support for these assertions, it is submitted that the rejection of the claims is improper and must be withdrawn.

It is further respectfully submitted that, to the extent that the Examiner is thinking of the commonly available "recall" or "previous channel" button of a remote control, a remote control having this button does not function "where the key pressed is automatically stored in the memory and can be reactivated or repeat or retransmit the next time the consumer electronic device is on" and does not function to "transmit commands from the remote control to a controlled device while the user is interacting with the locally displayed menu in a programming mode." Rather, a remote control having this button does nothing more than transmit a single, fixed command when the "recall" button is activated which single, fixed command is interpreted by the television as a command to revert itself to the previous channel. Thus, the operation of this conventional "recall feature" requires that the television save the previously tuned channel and revert to that channel in response to the receipt of the single, fixed command – no command is stored and repeated within the remote control.

IX. THE PROPOSED MODIFICATION OF ABECASSIS WOULD IMPERMISSIBLY CHANGE THE PRINCIPLE OF OPERATION OF ABECASSIS

Abecassis discloses a system that promotes the one-time entry of filtering parameters or playback sequencing for the purpose of storing the parameters within the system (not the remote). Abecassis emphasizes a desire to eliminate any need for the retransmission of parameter editing keystrokes (Col. 24, lines 20-36 which sets forth that the viewer "preestablish[es] ...personalized video content preferences...[such that],



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during transmission of the video, viewer intervention is not required"). Abecassis describes that a user edits a list of preference parameters which preference parameters, *as opposed to the keystrokes used to define them*, are stored in the system memory (not the remote memory) and automatically applied by the system during playback for the purpose of eliminating the need for further user intervention. (Col. 28, lines 28-33).

Thus, it is submitted that a modification of Abecassis to include a remote control that stores user entered keystroke data while the user transmits commands to an appliance and which allows the user to repeat the stored keystroke data to thereby *repeat the transmission of the same, previously transmitted commands to the appliance* would be a modification that is directly contrary to the very principle under which the system of Abecassis is intended to operate, i.e., the express desire of Abecassis to eliminate any need for the retransmission of parameters. Since it is impermissible to propose a modification of a reference that is contrary to its principle of operation, it is submitted that the rejection of the claims must be withdrawn.

**X. SINCE CROY DOES NOT DISCLOSE TRANSMITTING A SEQUENCE OF COMMANDS TO AN APPLIANCE, CROY CANNOT BE SAID TO DISCLOSE, TEACH, OR SUGGEST FURTHER CLAIM ELEMENTS RELATED TO THE TRANSMISSION OF A SEQUENCE OF COMMANDS**

The disclosure by Croy of a "delete" key that "allows removal of the marked program from the list" cannot be said to disclose, teach, or suggest the claimed "removing activations of non-navigation keys from the stored sequence." In this regard, the applicants respectfully question how a "marked program" *in a locally displayed menu* can be said to correspond to a "non-navigation key" which is activated as part of a *sequence used to transmit command codes* to a consumer electronic device for the

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purpose of navigating a digital media on that consumer electronic device. Likewise, the applicants respectfully question how removal of a "marked program from a list" *in a locally displayed menu* corresponds to "receiving data from the player used to define navigation commands that are transmittable to the player for controlling navigation of menu system."

XI. ABECASSIS DOES NOT DISCLOSE STORING INTER-PAUSE KEY TIMES

The applicants question how the voice response subsystem of Abecassis which accommodates commands such as play and stop can be said to correspond to the claimed means for storing inter-pause key times, i.e., the time between activations of keys in a sequence. More specifically, the applicants respectfully question where Abecassis even mentions considering "time."

XII. CROY CANNOT BE SAID TO ANTICIPATE THE CLAIMS

With respect to the rejection under 35 U.S.C. § 102, it is submitted that this rejection must be withdrawn since Croy fails to disclose the claimed "programming...for receiving data from the player used to define navigation commands that are transmittable to the player for controlling navigation within the menu system [of the media player] and for storing a sequence of the navigation command for subsequent retransmission to the player." While the Office Action has asserted that such is disclosed at Col. 19, lines 23 – 27 of Croy, it is noted that the disclosure in this cited passage only describes using a delete soft key to remove a marked program from a list of programs locally displayed in the device. Thus, this disclosure cannot be said to disclose, teach, or suggest the claimed receiving from a player data used to *define* navigation commands that are *transmittable* to the player for controlling navigation and for storing a sequence of navigation command

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for subsequent *transmission* to the player. As discussed extensively above, Croy fails to disclose, teach, suggest, or infer any system of method for storing a sequence of transmittable navigation commands. Therefore, since Croy fails to disclose, teach, or suggest each and every element set forth in the claims, it is respectfully submitted that the rejection based upon 35 U.S.C. § 102 is improper and must be removed.

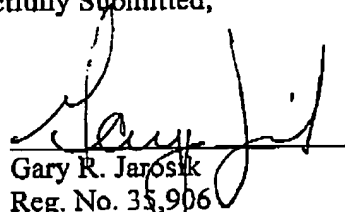
## XII. CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

Respectfully Submitted;

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